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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------------|---------------------|------------------|
| 10/538,359  | 06/13/2005  | Dirk Rottger                | 273059US0XPCT       | 5796             |
| 22850 7590 11/09/2009<br>OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                             |                     |                  |
| EXAMINER<br>CHUNG, SUSANNAH LEE   |             |                             |                     |                  |
| ART UNIT<br>1626  |             | PAPER NUMBER                |                     |                  |
| NOTIFICATION DATE<br>11/09/2009   |             | DELIVERY MODE<br>ELECTRONIC |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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### Office Action Summary

**Application No.**

10/538,359

**Applicant(s)**

ROTTGER ET AL.

**Examiner**

SUSANNAH CHUNG

**Art Unit**

1626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 3/26/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 1-6, 8, and 11-14 are pending in the instant application. Claims 7, 9, and 10 are canceled.

#### *Information Disclosure Statement*

The information disclosure statement (IDS), filed on 3/26/09 has been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

#### *Response to Non-Final Office Action*

Acknowledgment is made of applicant's response and amendment of the claims filed on 7/27/09.

Claims 1-9 were rejected under 35 U.S.C. 112, first paragraph, because **the specification although enabling for a process of making a final product of formula (I) (found in claim 3) reacting a metal of Group 6-10 (subject to the proviso) with a compound of formula (II) or (III) within the scope of formulae (V) to (X) (found in claim 2)** is not enabled for a process of making an undisclosed compound using a metal of Group 6-10 (subject to the proviso) with a compound of formula (II) or (III). Applicants arguments, amendment to the claims and intent are understood and acknowledged, but the claim language is overly broad and can include compounds not intended by Applicant. It is noted that the instant claims use comprising language which could include additional elements not seen in the claim. Without a description of the final product or the enabled intermediates, the process claim fails under the enablement standard. Applicants may overcome this enablement rejection by adding the enabled limitations, i.e. the final product and enabled intermediates (compounds of formula (V) to (X) into claim 1.

Claim 1 fails because the process claim is incomplete. The claim is incomplete because there is no final product to the process claim. Therefore the rejection is maintained.

Claims 1-9 were rejected for the terms "metal complexes," "reacting," and "complexes of metals of groups 6 to 10 of the Periodic Table of the Elements." This rejection will be overcome if the specific compounds are added into the claims because it will clarify the terms. Therefore the rejection is maintained.

Claims 1-9 were rejected under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) as being anticipated by and made obvious over McGuinness, et al (J.A.C.S., Vol. 123, No. 34, 2001). Applicant's arguments and amendments to the claims have been considered and are found persuasive for claims 1-6, 8 and 11-13, but are not found persuasive for claim 14. Applicants arguments are acknowledged, but are not found persuasive. Absent unexpected results between the two compounds, it is asserted that they will react the same way and have the same outcome and use, i.e. as catalysts. Claim 14 is also missing a final product in the claim, which makes the claim more obvious than if the final product, i.e. metal complex, were included in the claim. Therefore, claim 14 is rejected.

Claims 10-12 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 is canceled and the rejection is overcome. The rejection of Claims 11 and 12 are maintained because the terms "olefinic material," "nucleophile," and "the reaction product of Claim 1" are indefinite. First, the term "reaction product" lacks antecedent basis. There is no reaction product in Claim 1. The reaction product should be defined or the claim made dependent on the claims with the reaction product. Second, the terms olefinic

material and nucleophile are broad and the metes and bounds of the claim are unknown. The definitions found in claim 12 should be imported into claim 11. Appropriate correction is required.

Claim 13 was rejected under 112, 2<sup>nd</sup> paragraph for being indefinite. Claim 13 should be amended to clarify the product of the method. The phrase "in the presence of a catalyst of a metal complex (I) that is comprised of one or more compounds of formula II and/or III as prepared by the method of Claim 1" is indefinite. First the term "metal complex (I)" is unclear. If Applicants are referring to the "metal complex of formula (I)" in claim 3, the claim should be amended to read "metal complex of formula (I)" not "metal complex (I)." Second, the claim is dependent on claim 1, but claim 1 contains no reaction product so it is not clear what product claim 13 is referring. Therefore, this rejection is maintained.

#### Conclusion

The instant claims are mainly rejected because the claims are drawn to a process of making a metal catalyst, yet the metal catalyst does not appear in the claim. The metal catalyst or final product should appear in the process claim. Otherwise, the process claim is ambiguous.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Golam M. M. Shameem/  
Primary Examiner, Art Unit 1626

Susannah Chung